

REMARKS

In reply to the Office Action mailed December 15, 2005, Applicants have amended claims 28-30 and 34-37 to correct informalities and more clearly recite the subject matter of the invention. Applicants have added new claims 38-45 to claim additional aspects of the invention. Claims 1-10 were previously cancelled and claims 11-27 have been withdrawn by the Examiner. Claims 28-45 are currently under examination.

In the Office Action, the Examiner rejected claims 28, 32, and 34-37¹ under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,019,364 to Svyatsky et al. ("*Svyatsky*"), rejected claims 28, 32, and 34-37² under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,363,971 to Weeks et al. ("*Weeks*"), rejected claims 28, 30, and 34-37 under 35 U.S.C. § 103(a) as being unpatentable over *Weeks* in view of U.S. Patent No. 5,293,319 to DeShe et al. ("*DeShe*"), rejected claims 28, 30, and 34-37 under 35 U.S.C. § 103(a) as being unpatentable over *Svyatsky* in view of *DeShe*, rejected claims 29, 30, 32, and 33³ under 35 U.S.C. § 103(a) as being unpatentable over *Weeks* in view of U.S. Patent No. 6,549,892 to Sansone ("*Sansone*"), rejected claims 28-29 and 31-37⁴ under 35 U.S.C. § 103(a) as being unpatentable over *Svyatsky*

¹ The first sentence of part 7 of the office action on page 3 lists claims 28 and 34-37 as being rejected. The text below, however, discusses claim 32 as well.

² The first sentence of part 8 of the office action on page 3 lists claims 28 and 34-37 as being rejected. The text below, however, discusses claim 32 as well.

³ The first sentence of part 12 of the office action on page 5 does not list the claims that are rejected. The text below, however, discusses claims 29, 30, 32, and 33.

⁴ The first sentence of part 13 of the office action on page 6 lists claims 28-29 and 31-37 as being rejected. The text below, however, discusses only claims 29, 30, 32, and 33.

in view of *Sansone*, rejected claims 28-29 and 31-37⁵ under 35 U.S.C. § 103(a) as being unpatentable over *Weeks* in view of U.S. Patent No. 5,079,714 to Manduley et al. ("*Manduley*"), and rejected claims 28-29 and 31-37⁶ under 35 U.S.C. § 103(a) as being unpatentable over *Svyatsky* in view of *Manduley*. For the reasons below, Applicants traverse these rejections.

35 U.S.C. § 102(b) Rejections

In order to properly anticipate claims 28, 32, and 34-37 under 35 U.S.C. § 102(b), the cited reference must explicitly disclose each and every limitation recited in the claims. See M.P.E.P. § 2131 (8th ed., Aug. 2005 rev.). If the cited reference, however, fails to expressly set forth a particular limitation, then the Examiner must show that this limitation is inherently disclosed to substantiate a claim of anticipation. See *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). To establish inherency, the Examiner must specifically identify extrinsic evidence that makes clear to one skilled in the art that the missing limitation "is necessarily present" in the reference's disclosure. See *id.*; see also *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

In the Office Action, the Examiner rejected claims 28, 32, and 34-37 under 35 U.S.C. § 102(b) as being anticipated by *Svyatsky*. *Svyatsky* does not anticipate independent claim 28 because it fails to disclose each and every recited feature. Specifically, claim 28 recites a combination of features including, among others, a "mail interface system having an upward module carrying mail pieces up to an overhead transport positioned at a height above an output of the postage verifier, and a downward

⁵ The first sentence of part 14 of the office action on pages 6-7 lists claims 28-29 and 31-37 as being rejected. The text below, however, discusses only claims 29, 30, 32, and 33.

⁶ The first sentence of part 15 of the office action on pages 7-8 lists claims 28-29 and 31-37 as being rejected. The text below, however, discusses only claims 29, 30, 32, and 33.

module carrying mail pieces down from the overhead transport to the mail sorter,” “directing the mail pieces up the upward module,” “directing the mail pieces through the overhead transport,” and “directing the mail pieces down the downward module to the mail sorter.” *Svyatsky* does not disclose at least these features.

Svyatsky is directed to a system for re-orienting the direction that a document, such as a mail document, is facing in a transport system. (Abstract, col. 2, lines 26-33; col. 3, lines 10-33; Fig. 1 and related text). The *Svyatsky* system includes: 1) a document infeed station that automatically unloads a tray of documents provided to the station by an operator and lines the documents up single file in a vertical position between transport belts (col. 5, lines 18-25), 2) a document re-orienting apparatus for turning 180 degrees documents that are facing the wrong way, 3) an image lift station for imaging one side of the documents, and 4) an optional print module for coding documents according to the image information (col. 5, lines 26-48). The *Svyatsky* transport system delivers the correctly oriented documents to a sorting system that receives and stacks mail documents having a common destination, or ZIP, code. (Col. 5, lines 48-56).

Svyatsky does not disclose or suggest a “mail interface system having an upward module carrying mail pieces up to an overhead transport positioned at a height above an output of the postage verifier, and a downward module carrying mail pieces down from the overhead transport to the mail sorter” as recited in claim 28 because *Svyatsky* contains no mention of changing the height of the documents as they are transported, nor any motivation for wanting to change the height of the documents as they are transported. *Svyatsky* does not disclose “an upward module” or any device that

transports a document in an upward direction. *Svyatsky* does not disclose “an overhead transport” or any device that transports documents “at a height above an output of the postage verifier.” And, *Svyatsky* does not disclose “a downward module carrying mail pieces down from the overhead transport to the mail sorter” or any device that transports a document in a downward direction.

In addition, *Svyatsky* does not teach or suggest “directing the mail pieces up the upward module; directing the mail pieces through the overhead transport; [and] directing the mail pieces down the downward module to the mail sorter” as recited in claim 28 for the same reasons. Although the Examiner relied upon column 5, lines 1-55 of *Svyatsky* as the basis for rejecting these features of claim 28, Applicants respectfully submit that the Examiner’s basis for the rejection is unfounded because these portions of *Svyatsky* teach nothing related to directing documents up, down, or through an overhead transport, as recited in claim 28.

In the Office Action, the Examiner rejected claims 28, 32, and 34-37 under 35 U.S.C. § 102(b) as being anticipated by *Weeks*. The *Weeks* reference fails to disclose the same recited features lacking from the *Svyatsky* reference. *Weeks* is directed to a sorting machine, which sorts mail into the sequence needed by the mail carrier using a minimized number of stackers. (Abstract, col. 2, lines 27-45; col. 3, lines 9-12; Fig. 1 and related text).

Specifically, among other things, *Weeks* does not disclose or suggest a “mail interface system having an upward module carrying mail pieces up to an overhead transport positioned at a height above an output of the postage verifier, and a downward module carrying mail pieces down from the overhead transport to the mail sorter” as

recited in claim 28 because *Weeks* contains no mention of any type of system that carries the mail pieces to the sorter, no mention of changing the height of the documents as they are transported to the sorter, nor any reason to change the height of the documents as they are transported. More specifically, *Weeks* does not disclose “an upward module” or any device that transports a document in an upward direction. *Weeks* does not disclose “an overhead transport” or any device that transports documents “at a height above an output of the postage verifier.” And, *Weeks* does not disclose “a downward module carrying mail pieces down from the overhead transport to the mail sorter” or any device that transports a document in a downward direction to the sorter.

The only thing *Weeks* teaches related to transporting mail to the sorter is manual transportation by an operator. “Prior to sequencing, the operator loads the mail face down into sort stackers 1 through 11 up to a predetermined height. . . . Once the machine is loaded, it is ready to begin sequencing the mail.” Col. 5, lines 51-62. The Examiner cited to this portion of the *Weeks* in support of the section 102 rejection of claim 28, but *Weeks* clearly fails to disclose the recited features noted above. In fact, as stated in the present specification, *Weeks* is an example of the type of manually loaded conventional sorter system that the present invention improves over. “Current mail processing systems require an operator to arrange and carry mail between an AFCS/ISS, OCR, and DBCS/OSS [sorter]. Systems and methods consistent with the present invention . . . include a direct connect system to allow mail to be automatically processed and transported between the postage verifier and mail sorter, such as the DBCS/OSS.” (Appl. at page 4).

For at least the foregoing reasons, both *Svyatsky* and *Weeks* fail to disclose each and every element recited in independent claim 28. Thus claim 28 is allowable over both *Svyatsky* and *Weeks*. Consequently, claims 29-37, which depend directly from claim 28, are also allowable for at least the foregoing reasons. In addition, claims 34-37 are allowable for the additional reason that they recite features related to the downward module and the upward module that, as explained above, are not taught by *Svyatsky* or *Weeks*. Accordingly, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. § 102 rejections of claims 28, 32, and 34-37.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 28, 30, and 34-37 under 35 U.S.C. § 103(a) as being unpatentable over *Weeks* in view of *DeShe*, rejected claims 28, 30, and 34-37 under 35 U.S.C. § 103(a) as being unpatentable over *Svyatsky* in view of *DeShe*, rejected claims 29, 30, 32, and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Weeks* in view of *Sansone*, rejected claims 28-29 and 31-37 under 35 U.S.C. § 103(a) as being unpatentable over *Svyatsky* in view of *Sansone*, rejected claims 28-29 and 31-37 under 35 U.S.C. § 103(a) as being unpatentable over *Weeks* in view of *Manduley*, and rejected claims 28-29 and 31-37 under 35 U.S.C. § 103(a) as being unpatentable over *Svyatsky* in view of *Manduley*. For the reasons below, Applicants traverse these rejections.

To establish a prima facie case of obviousness under 35 U.S.C. § 103, the Examiner must factually demonstrate three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings to produce the claimed invention. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. See M.P.E.P. §§ 2142, 2143 (8th ed., Aug. 2005 rev.), citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

All the section 103 rejections rely on *Weeks* or *Svyatsky* for teaching or suggesting various features of claims 28-37.⁷ For the reasons explained above, neither *Weeks* nor *Svyatsky*, teaches or suggests, among other things, a “mail interface system having an upward module carrying mail pieces up to an overhead transport positioned at a height above an output of the postage verifier, and a downward module carrying mail pieces down from the overhead transport to the mail sorter,” “directing the mail pieces up the upward module,” “directing the mail pieces through the overhead transport,” and “directing the mail pieces down the downward module to the mail sorter” as recited in claim 28, and similar features recited in claims 29-37. None of the other cited references cure this deficiency, so the prior art references fail to teach or suggest all the claim limitations.

In addition, for all the reference combinations, the Examiner has not demonstrated any suggestion or motivation, either in the references themselves or in

⁷ For some of the section 103 rejections, the Office Action lists claim 28, but does not discuss, quote, or otherwise address it directly under the auspices of obviousness. Consequently, Applicants are unsure whether the Examiner is actually asserting a section 103 rejection of claim 28, in addition to the section 102 rejections of claim 28. In either case, claim 28 is allowable over the art of reference.

the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings to produce the claimed invention. Conclusory statements such as “[i]t would have been obvious for Weeks to orient the mail with the postage on the leading edge to read the postage and label address labeling without the need to rotate the image as taught by DeShe et al. and come up with the instant invention” (Office Action part 10 at page 4, see also, part 11, page 5, etc.) do not demonstrate suggestion or motivation. The Examiner has not presented any citations to prior art references, logical reasoning, or other demonstration of the knowledge in the art to support a finding of suggestion or motivation to combine.

Accordingly, for the reasons above, the Examiner has not established a prima facie case of obviousness with respect to claims 28-37, and these claims are allowable over the cited references. Applicants respectfully request the Examiner to withdraw the 35 U.S.C. § 103 rejections of claims 28-37.

New Claims 38-45

New claims 38-45, although varying in scope, recite features similar to those recited in claims 28-37. Applicants respectfully submit that claims 38-45 are therefore patentable over the cited references for at least the same reasons explained above.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

In the Office Action, the Examiner makes various statements regarding the teachings of the prior art references, the meaning of the claims, and the application of

the references to the claims. Applicants decline to automatically subscribe to or agree with any of the Examiner's statements.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 15, 2006

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